

- 3 -

REMARKS

1. In paragraph 5 of the Detailed Action the Examiner has rejected claims 1-54, 58, 59-99 and 103-107 as being anticipated by Dymetman et al (US 6,330,976) in view of Heckman. In response, the Applicant makes the following points:

(a) The Examiner states that "*Dymetman et al ...fail to disclose or fairly suggest [that] the visible information and the invisible information are disposed on the surface substantially simultaneously.*" The Applicant agrees with this statement.

(b) However, the Examiner then suggests that Heckman discloses the claimed feature. In reply, the Applicant submits that Heckman does not disclose a region in which "*the coded data and the additional data having been disposed on the surface substantially simultaneously*" and in which "*the coded data comprises machine-readable data which is substantially inscrutable to the average unaided human.*" Nowhere in Heckman is there any disclosure of the printing of machine-readable data which is substantially inscrutable to the average unaided human. The disclosure of the "latent" information in Heckman is not machine-readable data, but human-readable data. This latent information changes from being invisible to being visible when a copy is made of the secure document. This is so that a user can see that it is a forgery (See col. 9 line 59 to col. 10 line 3). Heckman therefore does not disclose a region in which "*the coded data and the additional data having been disposed on the surface substantially simultaneously*" as claimed in claim 1. Dymetman and Heckman therefore do not anticipate claim 1.

2. In paragraph 9, the Examiner contests the Applicant's argument that Dymetman does not disclose simultaneous printing of coded and additional data by suggesting that "*Dymetman is only providing an example of how the invention could be used. Figure 4 shows a security document where both visible and invisible information are printed thereon.*"

However, Figure 4 of Dymetman does not show a security document. It shows a map. The Examiner may be confusing Figure 4 of Dymetman with Figure 4 of Heckman. In any event, as argued above, Figure 4 of Heckman does not disclose any "*machine-readable data*" which is "*substantially inscrutable to the average unaided human*" and in which "*the coded data and the additional data having been disposed on the surface substantially simultaneously.*"

- 4 -

The Applicant maintains the position that Dymetman teaches away from simultaneous printing of coded and additional data since it teaches pre-printing of coded sheets for sale to publishers who then print additional data thereon.

The Applicant submits that neither Dymetman nor Heckman disclose any "machine-readable data" which is is "substantially inscrutable to the average unaided human" and in which "the coded data and the additional data having been disposed on the surface substantially simultaneously."

3. The Applicant notes that the Examiner has clearly ignored a large number of claims in his Examination. The Office Action only addresses issues concerning independent claims 1 and 59. The Examiner has not pointed out the relevance (if any) of the cited art to any of the dependent claims. The Examiner is requested to fully consider all 107 claims.

4. In paragraph 2 of the Office Action the Examiner has argued that there is no antecedent basis for "the coded data and the additional data having been disposed on the surface substantially simultaneously." In response, the Examiner's attention is drawn in particular to the section of the specification beginning on page 13 entitled "1.1 Netpages." The Applicant submits that one of ordinary skill in the art would understand from this description that the coded data and additional data are printed on Netpages substantially simultaneously.

5. The Applicant further challenges the Examiner's decision to make this action final for the following reasons:

(a) The Office Action raised Heckman as entirely new prior art. By making this action final the Examiner has limited the Applicant's ability to fully consider and respond to this new prior art. The Examiner has suggested in paragraph 10 that the "Applicant's amendment necessitated the new ground(s) of rejection." However, the Applicant points out that original claims 41 and 44 disclose a region in which both the tags and the additional information are printed by the same printer. These claims imply the simultaneous printing of coded and additional data which was explicitly included in the amendments to claim 1. Given the content of these original claims, the Applicant contests the Examiner's suggestion that the objections in the latest Office Action were necessitated by the Applicant's

- 5 -

amendment.

(b) As argued in paragraph 3 above, it is clear that the Examiner has not conducted a prior art search in respect of all of the claims. The Applicant has paid a significant amount of extra claim fees in order to have all 107 claims examined. The Applicant requests that the Examiner fully consider all of these claims and issue a further Office Action which deals with these clearly ignored claims.

Should the Examiner ignore this request to fully consider all 107 claims the Applicant reserves the right to take the issue up with the Examiner's supervisor, Michael G Lee.

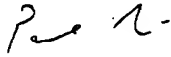
- 6 -

CONCLUSION

It is respectfully submitted that all of the Examiner's objections have been successfully traversed. Accordingly, it is submitted that the application is now in condition for allowance. Reconsideration and allowance of the application is courteously solicited.

Very respectfully,

Applicant:



PAUL LAPSTUN

KIA SILVERBROOK

SIMON ROBERT WALMSLEY

C/o:

Silverbrook Research Pty Ltd
393 Darling Street
Balmain NSW 2041, Australia

Email: kia.Silverbrook@silverbrookresearch.com

Telephone: +612 9818 6633

Facsimile: +61 2 9818 6711

FAX RECEIVED

MAR 25 2003

TECHNOLOGY CENTER 2800